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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/545,772	04/10/00	WILKINS	T 420522000100

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HM12/0419

EXAMINER

FORD, V

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

04/19/01

*6*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/545,772	Applicant(s) WILKINS ET AL.	
	Examiner Vanessa L. Ford	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 10 April 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-61 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-39 are drawn immunogenic composition comprising a (polypeptide and polysaccharide) and vaccine classified in class 530, subclass 300.
  - II. Claims 40-52 are drawn to a method for producing a protein and polysaccharide, classified in 530, subclass 300.
  - III. Claim 53-60 are drawn to a polynucleotide, classified in class 536, subclass 23.7.
  - IV. Claim 61 is drawn to a method of using an immunogenic composition comprising a polypeptide and polysaccharide class 424, subclass 185.1.
2. Groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the composition (polypeptide and polysaccharide) of Group I can be used as a molecular weight marker or in an immunoassay.

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3. Groups I and III are related as products. Group I is drawn to an immunogenic composition comprising a (polypeptide and polysaccharide) and a vaccine. Group III is drawn to a polynucleotide comprising a nucleotide sequence. The inventions are patentably distinct, each from the other, because they are distinct products, which are different structurally and functionally.

4. Groups I and IV are product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a material different process of using that product (MPEP 806.05(h)). In the instant case the inventions of Group I may be used for a number of different processes that are very much unrelated. For example, the (polypeptide and polysaccharide) of Group I can be used as a molecular marker or in an immunoassay.

5. Groups II and III are unrelated. Group II is drawn to a method of making an immunogenic composition comprising a protein and a polysaccharide. Group III is drawn to a polynucleotide. The product of Group III is not required for the method of Group II. The Groups are materially distinct and independent from each other as claimed.

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6. Groups II and IV are related as methods. Group II is drawn to a method of making an immunogenic composition comprising a protein and a polysaccharide. Group IV is drawn to a method of using an immunogenic composition comprising a polypeptide and polysaccharide. They differ because they have different goals, require different method steps and parameters.

7. Groups III and IV are unrelated. Group III is drawn to a polynucleotide. Group IV is drawn to a method of using an immunogenic composition comprising a polypeptide and a polysaccharide. The product of Group III is not required for the method of Group IV. The Groups are materially distinct and independent from each other as claimed.

8. Restriction to one of the following inventions is required under 35 U.S.C. 121: The inventions are distinct, each from the other because of the following reasons: Because these inventions are distinct for the reasons given and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper. Moreover, in the absence of restriction it would place an undue search and examination burden on the examiner.

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9. Applicant is advised that the reply to this requirement to be complete must include an election of invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

11. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (703) 308-4242.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (703) 305-4735. The examiner can normally be reached on Monday – Friday from 7:30 AM to 4:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909.



Vanessa L. Ford  
Biotechnology Patent Examiner  
April 4, 2001



PATRICIA A. DUFFY  
PRIMARY EXAMINER